

REMARKS

Claims 1-3, 6-7, 18, 20-24, and 26-31 are currently pending in the present application. Support for the amendments made to claim 1 herein can be found, for example, in claim 1 as originally filed. Reconsideration and reexamination of the present application is respectfully requested in view of the amendments above and the remarks which follow.

Claims Rejected Under 35 U.S.C. 102(e)

The Examiner rejected claims 1-3 and 6-7 under 35 U.S.C. 102(e) as allegedly being anticipated by Campfield et al. (U.S. Pat. No. 6,025,325, hereinafter the '325 patent). The present rejection is respectfully traversed for the reasons which follow.

Applicants respectfully submit that the '325 patent does not expressly teach conferring resistance to endotoxic shock in an animal in need of resistance to endotoxic shock. Therefore, the '325 patent cannot expressly anticipate that present invention because the '325 patent does not expressly teach each and every element of the claimed invention.

The Examiner next asserts that the "limitations of 'conferring resistance to endotoxic shock', the shock 'occurs in sepsis' and 'occurs in systemic inflammatory response syndrome' are intended use recitations and these limitations would still be met by the administration of leptin for another purpose" implying that the present claims are inherently anticipated. Applicants respectfully submit that the present claims are not inherently anticipated by the '325 patent for the following reasons.

Federal Circuit decisions emphasize that an anticipatory inherent feature or result must be consistent, necessary and inevitable, not merely possible or probable (see, e.g., *Chisum on Patents* 1:3.03[2][b]). Also, "anticipation by inherent disclosure is appropriate only when the reference discloses prior art that must necessarily include the unstated limitation" (emphasis in the original, see, e.g., *Transclean Corp. v. Bridgewood Services, Inc.*, 290 F.3d 1364, 1373, 62 USPQ2d 1865 (Fed. Cir. 2002)).

The '325 patent discloses that, "Human ob protein (hob) refers to the protein of SEQ ID NO:6 whose biological properties relate to the treating, controlling or preventing obesity or its associated conditions and diseases" (see column 4, lines 59-62). Claims 1-3 and 6-7, as amended herein, recite a "method for conferring resistance to endotoxic shock in an animal in need of resistance to endotoxic shock". The Examiner has failed to provide any evidence that the '325 patent teaches a method of conferring resistance to endotoxic shock in an animal in need of resistance to endotoxic shock. The need for resistance to endotoxic shock is not a "consistent, necessary and inevitable" feature of obesity. For example, it does not follow that all individuals with endotoxic shock are consistently, necessarily, and inevitably obese. Therefore, the present rejection should be withdrawn because the '325 patent does not disclose or suggest either explicitly or inherently all of the elements of the claimed invention.

Claims Rejected Under 35 U.S.C. 112, First Paragraph

Claims 18, 20-24, and 27 are rejected under 35 U.S.C. 112, first paragraph as allegedly lacking enablement in the specification for reasons of record in the previous Office

Actions. The present rejection is respectfully traversed for reasons on the record including the reasons set forth in the Appeal Brief mailed February 12, 2004.

Claims Rejected Under 35 U.S.C. 103(a)

Claims 18, 20-24, 26, and 28-31 are rejected under 35 U.S.C. 103(a) as allegedly being obvious over Grunfeld et al. (J. Clin. Invest 97(():2152-2157, 1996) for the reasons of record in the previous Office Actions. The present rejection is respectfully traversed for reasons on the record including the reasons set forth in the Appeal Brief mailed February 12, 2004.


CONCLUSION

Claims 1-3, 6-7, 18, 20-24, and 26-31 are currently pending in the present application. No new matter is added by way of the present Amendment. Applicant believes that claims 1-3, 6-7, 18, 20-24, and 26-31 are in condition for allowance and earnestly solicits an early notification of allowance from the Examiner.

The Commissioner is hereby authorized to charge Deposit Account No. 19-0962, should any additional fees be required in this application.

Respectfully submitted,

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Date


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